

Appl. No. 09/703,419
Amdt. Dated August 11, 2005
Reply to Office Action of July 14, 2005

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REMARKS

Claims 1, 4, 6, and 10 through 15, remain pending in this case.

5 The Office Action states that Claims 1, 4, 6, 10 and 12-15 stand rejected under
35 U.S.C. 103(a) as being unpatentable over Platte et al. U.S. 4,864,409 in view of
Saburi U.S. 6,556,235. The Office Action indicates that "Platte discloses in Figures 2
and 3 a video camera including an acceleration compensation apparatus, and further
mentions that portable (hand held) cameras have a risk of capturing adversely affected
10 images due to inadvertent (shake) of the camera housing (col. 1, lines 14-20).

The Office Actions accedes that Platte fails to disclose of the camera having the
capability of being integrated into a telephone. The Office Action maintains that Saburi
discloses in figures 1-3 a portable videophone unit that is provided with a camera (22)
15 for taking images (col.3, lines 32-54) and thus contends that "it would have been
obvious for one skilled in the art to have been motivated to integrate the camera
including an acceleration compensation apparatus disclosed by Platte into the hand
held telephone as disclosed by Saburi. Applicants respectfully traverse this rejection.

20 Before distinguishing the claims as now presented from the cited references, it is
important to understand the main purpose of the invention as now claimed. More

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specifically, on page 1, lines 23 through 28, it is indicated that conventional hand-held devices incorporating cameras lack stability of the image content, as a user manipulates the device. The present invention as taught provides electronic processing without the use of a motor or motors for providing a stable image in a hand-held device
5 incorporating imaging means, even with movement of a user's hand holding the device.

On page 4, line 33, extending into page 5, it is indicated that the present invention can in one embodiment use an electronically adjustable camera 102 having a wide field of view. It is also indicated on lines 8 through 10 on page 5, that the invention uses a camera having only electronic zoom capability.

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It is further indicated that the invention can utilize a camera having only electronic pan, tilt, and zoom (see page 5, lines 3 and 4). As further taught in the present Application, as long as an object remains in the wide field of view of the camera, the electronic processing utilized tracks and maintains the framing of the object of interest
15 in the image or images in order to maintain stabilization of the image in the presence of movement of a user's hand holding the hand-held device.

Platte simply teaches a television camera having an acceleration compensation apparatus. However, it fails to disclose the television camera operatively associated
20 with a hand-held processing device including PDA's, mobile telephones, palmtops and portable computers. There is no teaching in Platte comprising a hand-held processing device in the form of an information processing device that provides a user interface for

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control of information processing functions other than camera-related functions. Nor does Platte teach the use of a hand-held video camera having a wide field of view.

With regard to Saburi, Applicants agree that Saburi discloses a portable videophone unit. However, Saburi does not disclose or teach the use of solely electronic adjusting systems for providing a stable image in the presence of movement of a user's hand holding the portable videophone unit. In fact, there is no discussion of the use of a tracking capability to "maintain a desired framing of the object of interest within an image generated by the camera as a user manipulates the device, for providing a stable image" as claimed by the Applicants. Saburi teaches a system for automatically responding to an incoming call and two way communication using images, in a manner insuring the security of a call recipient party (see Abstract, and Col 2, lines 39-44). Saburi uses the calling party's telephone number and/or a personal identification number to insure the security of the recipient (see Col. 2, lines 45-47). Saburi clearly has no relation to Applicants invention other than in using a portable videophone unit, and thus, teaches away from the present invention as claimed.

Claim 1 as previously amended is clearly patentable over Platte and Saburi, whether taken individually or in any combination. Platte and Saburi do not teach the steps of Claim 1 (previously amended). Based on the above discussion, there would be no reason for one of skill in the art to ever consider combining these references together. Accordingly, Claim 1 (previously amended) is free of these references.

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Claims 4, 6, 10 and 11-13 are ultimately dependent from claim 1, and thus are patentable at least for the same reasons as claim 1.

5 Claims 14 and 15 as each previously amended are directed to the apparatus of the present invention. The comments made to Claim 1 above are likewise applicable in the present claims. Thus, Claims 14 and 15 as each previously amended are clearly patentable over Platte and Saburi, whether taken individually or in any combination. Platte and Saburi do not teach the elements of Claim 14 (previously amended) or of
10 Claim 15 (previously amended). Accordingly, Claims 14 (previously amended) and 15 (previously amended) are free of these references.

 The undersigned would like to bring to the Examiner's attention case law that clearly advises why Platte and Saburi do not make Applicant's invention as claimed
15 obvious. The courts have long held that there must be some teaching in the references cited to suggest the combination of the references in a manner to obtain the combination of elements of the rejected claim(s). It is well known that in order for any prior art references themselves to be validly combined for use in a prior-art § 103 rejection, the references themselves, or some other prior art, must suggest that they be
20 combined. For example:

 The Board has stated in Ex parte Levengood, 28 USPQ 2d 1300 (PTOBA&I

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1993):

5 "In order to establish prima facie case of obviousness, it is necessary for
the examiner to present evidence, preferably in the form of some
teaching, suggestion, incentive or inference in the applied prior art, or in
the form of generally available knowledge, that one having ordinary skill
in the art would have been led to combine the relevant teachings of the
10 applied references in the proposed manner to arrive at the claimed
invention. ... That which is within the capabilities of one skilled in the art is
not synonymous with obviousness. ... That one can reconstruct and/or
explain the theoretical mechanism of an invention by means of logic and
sound scientific reasoning does not afford the basis for an obviousness
15 conclusion unless that logic and reasoning also supplies sufficient
impetus to have led one of ordinary skill in the art to combine the
teachings of the references to make the claimed invention...."

As was further stated in Uniroyal, Inc. v Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434
(C.A.F.C. 1988),

20 "where prior art references require selective combination by the court to
render obvious a subsequent invention, there must be some reason for
the combination other than hindsight gleaned from the invention itself
Something in the prior art must suggest the desirability and thus the
obviousness of making the combination."
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Also, the case law is clear in guarding against the use of hindsight in reading
Applicants invention into the prior art, which art is clearly not disclosing the Applicants
invention as claimed. Applicants would like to bring the following cases to the
Examiner's attention:

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The Supreme Court in Calmar, Inc. v. Cook Chemical Co., 383 U.S. 1, 86 S.Ct.

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684, 15 L.Ed.2d 545 (1966), in which the Court warns the dangers of "slipping into hindsight", citing the case of Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406, 141 U.S.P.Q. 549 (6th Cir., 1964), where the doctrine is stated:

5 We now come to the patented device which after all is the subject matter
of this case. At the outset we take note of two well-established principles.
The first is that in considering the questions of obviousness, we must
view the prior art from the point in time prior to when the patented device
10 was made. Many things may seem obvious after they have been made
and for this reason courts should guard against slipping into use of
hindsight. We must be careful to "view the prior art without reading into
that art the teachings of appellant's invention." Application of Sporck, 301
F.2d 686, 689 (C.C.P.A).

15 Applicants have shown that the claims as now presented are patentable over the
cited references, whether taken individually or in any combination. Accordingly, it is
respectfully requested that the claims be allowed, and the case passed to issue.

Respectfully submitted,

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